

REMARKS

The Examiner rejected claims 10-24, 31, 32, 35, 40 and 42 under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 29-34 of U.S. Patent No. 6,370,090.

The Examiner rejected claims 10-19, 22, 23, 25, 27, 29, 31, 33 and 35 under 35 U.S.C. 103(a) as allegedly being unpatentable over Nishida et al. (U.S. Patent 5,384,674) in view of Yonemitsu et al. (U.S. Patent 5,592,450).

The Examiner objected to claims 20, 21, 24, 26, 28, 30, 32, 34 and 36-42 as allegedly being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicants gratefully acknowledge the Examiner's indication of allowable subject matter.

Applicants respectfully traverse the double patenting rejection and the §103 rejections with the following arguments.

**Double Patenting**

The Examiner rejected claims 10-24, 31, 32, 35, 40 and 42 under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 29-34 of U.S. Patent No. 6,370,090 to Verbakel et al. ("Verbakel '090"). Since the Examiner's arguments are largely based on claim 22 of the Verbakel '090, Applicants assume that the Examiner made a typographical error and intended the double patenting rejection of claims 10-24, 31, 32, 35, 40 and 42 to be over claims 22-34 of Verbakel '090.

To begin with, Applicants respectfully contend that the double patenting rejection of claims 10-21 of the present patent application is per se defective, because claims 10-21 of the present patent application are method claims, whereas claims 29-34 of Verbakel '090 do not disclose any method steps and thus do not disclose any of the method steps of claims 10-21 of the present patent application. Aside from this point regarding the method claims 10-21 of the present patent application, Applicants next analyze the Examiner's basis for the double patenting rejection.

As to claim 10, Applicants respectfully contend that claims 29-34 of Verbakel '090 do not disclose the feature: "providing at least two mutually logically conforming sub-TOCs for the same track area in one or more track areas of a unitary storage medium". The Examiner argues that the preceding feature of claim 10 is disclosed in Verbakel '090, claim 22, lines 9 and 10. In response to the preceding argument by the Examiner, Applicants respectfully contend that lines 9 and 10 of claim 22 of Verbakel '090 does not teach or suggest said "providing at least two mutually logically conforming sub-TOCs ..." step inasmuch as claim 22 of Verbakel '090 is not a method claim and thus does not disclose any "providing" step.

Also as to claim 10, Applicants respectfully contend that claims 29-34 of Verbakel '090 do not disclose the feature: "each [mutually logically conforming] sub-TOC having structures for storing information for determining the configuration of the same information items stored in the track area". The Examiner argues that the preceding feature of claim 10 is disclosed in Verbakel '090, claim 22, lines 2-5, alleging: "TOC stores items configuration". In response to the preceding argument by the Examiner, Applicants respectfully contend that lines 2-5 of claim 22 of Verbakel '090 recites: "a unitary storage medium having a Table-of-Contents (TOC) mechanism adapted to specify an actual configuration of only audio items on the unitary storage medium". Thus, 2-5 of claim 22 of Verbakel '090 does not disclose anything about the structures of the two mutually logically conforming sub-TOCs as recited in claim 10. Accordingly, Applicants respectfully maintain that claim 10 of the present patent application is not obvious over claim 22 of Verbakel '090.

Also as to claim 10, Applicants respectfully contend that claims 29-34 of Verbakel '090 do not disclose the feature: "thereby allowing retrieving the configuration of the same information item in the track area from at least any correct copy of the sub-TOCs". The Examiner argues that the preceding feature of claim 10 is disclosed in Verbakel '090, claim 22, lines 9-11, alleging: "any one of the two mutually logically conforming sub-TOCs can be retrieved". In response to the preceding argument by the Examiner, Applicants respectfully contend that lines 9-11 of claim 22 of Verbakel '090 does not teach or suggest that "the configuration of the same information item in the track area from at least any correct copy of the sub-TOCs" can be retrieved, as alleged by the Examiner. Accordingly, Applicants respectfully maintain that claim 10 of the present patent application is not obvious over claim 22 of Verbakel '090.

Also as to claim 10, Applicants respectfully contend that claims 29-34 of Verbakel '090 do not disclose the feature: "providing at least one master-TOC having structures for storing information for determining the position of the sub-TOCs". The Examiner argues that the preceding feature of claim 10 is disclosed in Verbakel '090, claim 22, lines 11 and 13. In response to the preceding argument by the Examiner, Applicants respectfully contend that lines 11 and 13 of claim 22 of Verbakel '090 does not teach or suggest said "providing at least one master-TOC ..." step inasmuch as claim 22 of Verbakel '090 is not a method claim and thus does not disclose any "providing" step.

Based on the preceding arguments, Applicants respectfully contend that claim 10 of the present patent application is not obvious over claims 29-34 of Verbakel '090. Since claims 11-21 depends from claim 10, Applicants respectfully contend that claims 11-21 of the present patent application are likewise not obvious over claims 29-34 of Verbakel '090.

As to claim 22-24 and 36, Applicants respectfully contend that claims 22-24 and 36 are not obvious over claims 29-34 of Verbakel '090. The Examiner alleges: "With respect to the present claims 22-24 and 36, its subject matters are also claimed in the '090 patent and are rejected for the same reasons of obviousness double patenting as used above". In response, Applicants respectfully maintain that the double patenting rejection of claims 22-24 and 36 is improper because the Examiner's identification of "the same reasons of obviousness double patenting as used above" is ambiguous and does not state an argument that Applicants can specifically respond to. Under the circumstances, Applicants assert that Applicants' argument against the double patenting rejection of claims 22-24 and 36 is included within Applicants'

arguments presented *supra* in relation to the double patenting rejection of claims 10-21.

As to claims 31, 32, and 40, Applicants respectfully contend that claims 31, 32, and 40 are not obvious over claims 29-34 of Verbakel '090. The Examiner alleges: "With respect to the present claims 31, 32 and 40, its subject matters are also claimed in the '090 patent and are rejected for the same reasons of obviousness double patenting as used above". In response, Applicants respectfully maintain that the double patenting rejection of claims 31, 32, and 40 is improper because the Examiner's identification of "the same reasons of obviousness double patenting as used above" is ambiguous and does not state an argument that Applicants can specifically respond to. Under the circumstances, Applicants assert that Applicants' argument against the double patenting rejection of claims 31, 32, and 40 is included within Applicants' arguments presented *supra* in relation to the double patenting rejection of claims 10-21.

As to claims 35 and 42, Applicants respectfully contend that claims 35 and 42 are not obvious over claims 29-34 of Verbakel '090. The Examiner alleges: "With respect to the present claims 35 and 42, its subject matters are also claimed in the '090 patent and are rejected for the same reasons of obviousness double patenting as used above". In response, Applicants respectfully maintain that the double patenting rejection of claims 35 and 42 is improper because the Examiner's identification of "the same reasons of obviousness double patenting as used above" is ambiguous and does not state an argument that Applicants can specifically respond to. Under the circumstances, Applicants assert that Applicants' argument against the double patenting rejection of claims 35 and 42 is included within Applicants' arguments presented *supra*

in relation to the double patenting rejection of claims 10-21.

35 U.S.C. 103(a)

The Examiner rejected claims 10-19, 22, 23, 25, 27, 29, 31, 33 and 35 under 35 U.S.C. 103(a) as allegedly being unpatentable over Nishida et al. (U.S. Patent 5,384,674) in view of Yonemitsu et al. (U.S. Patent 5,592,450).

Applicants respectfully contend that claim 10 is not unpatentable over Nishida et al. in view of Yonemitsu et al., because Nishida et al. in view of Yonemitsu et al. does not teach or suggest each and every feature of claim 10. For example, Nishida et al. in view of Yonemitsu et al. does not teach or suggest:

"providing at least two mutually logically conforming sub-TOCs for the same track area in one or more track areas of a unitary storage medium, each sub-TOC having structures for storing information for determining the configuration of the same information items stored in the track area, thereby allowing retrieving the configuration of the same information item in the track area from at least any correct copy of the sub-TOCs".

The Examiner admits that

"Nishida does not teach the following:

- (a) as in claim 10, providing an additional mutually logically conforming sub-TOC for the same track area in one or more track areas of a unitary storage medium;
- (b) as in claim 10, the additional sub-TOC having structures for storing information for determining the configuration of the same information items stored in the track area, thereby allowing retrieving the configuration of the same information item in the track area from at least any correct copy of the sub-TOCs".

The Examiner alleges, however, that Yonemitsu teaches the preceding items (a) and (b) not taught

by Nishida. The Examiner argues that

“Refer to the feature not taught by Nishida in claim 10,...: There is an advantage of duplicating a TOC file in the event the original TOC file cannot be read. For example, Yonemitsu's file structure has a copy of the TOC file as redundant TOC information. Hence, it would have been obvious to one of ordinary skill in the art at the time of invention to make an additional TOC file such as Nishida's chapter 2 TOC file within the chapter similar to Yonemitsu's, because the extra TOC information in the same chapter/track area can protect the TOC file when any part of it cannot be read properly. And since the Chapter 2 TOC file of Nishida's is a sub-TOC file, its copy is also a sub-TOC file as in Applicant's claim 10.”

The preceding argument by the Examiner for modifying Nishida with Yonemitsu includes the allegation that “the extra TOC information in the same chapter/track area can protect the TOC file when any part of it cannot be read properly”. In response, Applicants contend that the Examiner's argument taken to its logical limit effectively suggests duplicating not only the sub-TOCS in Nishida but also the master-TOC and also all of the data pointed to by the various TOCs and sub-TOCS, since the Examiner has not provided a basis for protecting only the sub-TOC data and not protecting the other data on the storage medium. In other words, the Examiner's argument taken to its logical limit would require duplication of all of the data on the storage medium in order to protect against any unreadable data on the storage medium, since all of the data on the storage medium could potentially be unreadable and, based on the Examiner's argument, allegedly should be backed up with duplicate data. Applicants contend that duplication



of all of the data on the storage medium would be extremely wasteful and expensive. Thus, Applicants respectfully contend that it is not obvious to add an additional mutually logically conforming sub-TOC to Nishida.

Additionally, having an additional mutually logically conforming sub-TOC as required by claim 10 is irrelevant to the objects of Nishida's invention. In col. 1, lines 61-65, Nishida states two objects. As to the first object, Nishida states: "An object of the present invention is to improve handling of an image recording/reproducing apparatus." Applicants contend that having an additional mutually logically conforming sub-TOC as required by claim 10 would not enhance the preceding first object of Nishida's invention. As to the second object, Nishida states: "Another object of the present invention is to achieve a quick search of image data by an image recording/reproducing apparatus." Applicants contend that having an additional mutually logically conforming sub-TOC as required by claim 10 would not enhance the preceding second object of Nishida's invention. Thus, having an additional mutually logically conforming sub-TOC as required by claim 10 would not enhance any object of Nishida's invention. Moreover, there is no teaching or suggestion of any kind in Nishida that would imply that Nishida's invention would be improved in any manner by having an additional mutually logically conforming sub-TOC as required by claim 10. Thus, Applicants respectfully contend that it is not obvious to add an additional mutually logically conforming sub-TOC to Nishida.

Applicants additionally note that Yonemitsu provides the following reason in col. 11, line 66 - col. 12, line 4 for providing a copy of the TOC: "some computer applications do not easily recognize data recorded in sectors having negative addresses (such as sectors -32 to -1 of the TOC information recorded in the lead-in area". However, Nishida does not teach storing a sub-TOC in

sectors having negative addresses. Thus, a person of ordinary skill in the art would have no motivation to incorporate the duplicate TOCs of Yonemitsu into Nishida's invention, because the situation that motivates Yonemitsu to use duplicate TOCs does not exist in Nishida.

Based on the preceding arguments, Applicants respectfully maintain that claim 10 is not unpatentable over Nishida et al. in view of Yonemitsu et al., and that claim 10 is in condition for allowance. Since claims 11-21 depend from claim 10, Applicants contend that claims 11-21 are likewise in condition for allowance.

In addition, Applicants maintain that dependent claims 11-21 have additional patentable features which make claim 11-21 patentable over Nishida in view of Yonemitsu. For example, the Examiner admits that neither Nishida or Yonemitsu teaches or suggests the following feature of claim 16: "wherein two sub-TOCs assigned to the track area are positioned at opposite ends of the track area". Accordingly, claim 16 cannot be rejected over Nishida in view of Yonemitsu, since Nishida in view of Yonemitsu does not teach or suggest each and every feature of claim 16 as the Examiner admits.

The Examiner alleges that independent claims 22, 25, 27, 29, 31, 33, and 35 "are drawn to the apparatus corresponding to the method of using the same as claimed in claims 10, 11 and 13". Therefore, based on the arguments presented *supra* in relation to independent claim 10, Applicants respectfully maintain that claims 22, 25, 27, 29, 31, 33, and 35 are not unpatentable over Nishida et al. in view of Yonemitsu et al., and that claims 22, 25, 27, 29, 31, 33, and 35 are in condition for allowance. Since claims 23-24 depend from claim 22, Applicants contend that claims 23-24 are likewise in condition for allowance. Since claim 26 depends from claim 25,

Applicants contend that claim 26 is likewise in condition for allowance. Since claim 28 depends from claim 27, Applicants contend that claim 28 is likewise in condition for allowance. Since claim 30 depends from claim 29, Applicants contend that claim 30 is likewise in condition for allowance. Since claim 32 depends from claim 31, Applicants contend that claim 32 is likewise in condition for allowance. Since claim 34 depends from claim 33, Applicants contend that claim 34 is likewise in condition for allowance.

**CONCLUSION**

Based on the preceding arguments, Applicants respectfully believe that all pending claims meet the acceptance criteria for allowance and therefore request favorable action. If the Examiner believes that anything further would be helpful to place the application in better condition for allowance, Applicants invite the Examiner to contact Applicants' representative at the telephone number listed below.

Date: 09/16/2003

Jack P. Friedman  
Jack P. Friedman  
Registration No. 44,688

Schmeiser, Olsen & Watts  
3 Lear Jet Lane, Suite 201  
Latham, New York 12110  
(518) 220-1850

**RECEIVED  
CENTRAL FAX CENTER  
SEP 16 2003**

**OFFICIAL**